

REMARKS

Favorable reconsideration of this application is respectfully requested.

Claims 1-55 are pending in this application. Claims 1-55 were rejected under 35 U.S.C. § 102(e) as anticipated by U.S. patent 6,658,568 to Ginter et al. (herein “Ginter”).

Addressing the above-noted rejection, applicants respectfully submit the claims as currently written clearly distinguish over Ginter.

The applicants of the present invention recognized that a problem exists with respect to determining when information released on a network, such as the Internet, becomes available as a publication, for example as prior art to a patent application. As a result one object of the present invention is to provide a novel system and method to certify the existence of electronic information released on a network, such as the Internet, at a prescribed time and date.¹

With the claimed system, a confirmation procedure is set in place to determine when electronic information is released on a network, so that if at a future time someone wishes to rely upon that electronic information, e.g., as prior art, there will be a certification as to the time and date of release of the electronic information, i.e., its publication.

The claims recite a structure such as shown in Figure 1 of the present specification in which, for example, a first server 3 may have information stored therein that is desired to be securely provided as a potential prior art reference for a patent search, as an example. In the operation of the present invention, that first server 3 can indicate a request to another server on the network, second server 5 in Figure 1, to access its prescribed electronic information 31, obtain a copy of its prescribed electronic information 31, generate information of a location, time, and date when the second server 5 access the prescribed electronic information 31, generate a prescribed electronic certificate specifying the electronic information 31 and

¹ See for example the present specification at page 3, lines 3-7.

attribute information, obtain and store the prescribed electronic certificate, and store either a copy of the electronic information 31 or attribute information. In the claimed invention each of those operations is performed by the second server 5.

The claims also recite that the at least one computer server on the network, such as the second server 5 in Figure 1 of the present specification, also has first and second memories that can store the electronic certificate and either a copy of the electronic information or the attribute information. That subject matter is fully supported by the original specification for example at page 12, line 16 et seq.

Thus, the claimed invention provides a structure and operation in which a third party (second server 5) can take all necessary steps to ensure that the information 31 requested by the first server 3 is authenticated and stored to be available as a future prior art reference for a patent search, as an example.

The features recited in the claims are believed to clearly distinguish over Ginter.

First, applicants believe the outstanding rejection is completely improperly interpreting the teachings in Ginter with respect to the claimed features. The outstanding Office Action cites several unrelated portions in Ginter in a way to try to meet the claimed limitations. However, the claims set forth a coherent and interrelated structure, which clearly differs from the disparate disclosures in Ginter cited in the Office Action.

Applicants initially address the “Response to Arguments” section in maintaining the rejection. As will be clear from the following discussion Ginter clearly fails to teach or suggest the claimed features, and the basis for the outstanding rejection is misconstruing the teachings in Ginter.

First, in the “Response to Argument” section, addressing point A that a rearrangement of location of parts is not patentable is not understood. The claims do not merely recite a

rearrangement of the parts in Ginter but clearly recite different elements performing different functions. The Office Action is not properly considering the positive recited claim features.

With respect to point B to the limitation to an “accessing device configured to access electronic information stored in one of the plurality of client computers using information of its location from one of the computer servers based on a request from one of the plurality of client computers”, that feature is simply neither taught nor suggested in Ginter.

The basis to maintain the rejection now appears to cite Ginter at Figure 52 and the disclosure at column 88, line 50 to column 90, line 42 directed to the “Secure Directory Services” device. In that respect applicants note Ginter merely discloses that element being an archive that can provide secure information upon qualified demands.²

The claims, however, are directed to more than merely an archive.

With reference to Figure 1 in the present specification as a non-limiting example, the server 5 can access an electronic information in the server 1 based on a request from the server 1 providing the location of the electronic information. That is, for example the operator of the server 1 may have prior art they wish to make available for patent searches. The operator of server 1 can then request that the server 5 access server 1 to retrieve that document, by the operator of server 1 giving location information of the document to server 5.

The Secure Directory Services element shown in Figure 52 of Ginter has no such operation. The Secure Directory Services device does not receive a request from a client computer indicating a location of an electronic document, and does not use that location to access a computer to access that document. The basis for the outstanding rejection is completely misconstruing the claim features in that respect.

² Ginter at column 89, lines 60-67.

Further, the point D in the “Response to Arguments” section is not at all understood and appears nonsensical. The noted disclosure in Ginter at column 49, lines 38-46 merely notes a financial clearinghouse 200 can analyze an audit trail 228 to generate one or more summary reports 240. How such a feature is related to the claim invention is not at all understood. The claim invention allows obtaining and storing the electronic information in a memory and storing in a separate memory storing an electronic certificate, the electronic certificate uniquely specifying the electronic information and attribute information. The reference to the financial clearinghouse 200 in Ginter appears nonsensical with respect to such a claim feature.

Moreover, the other points noted in the “Response to Argument” section all do not even attempt to address applicants previously presented arguments to the allowability of the claims or the applied art, which are now repeated below. Applicants respectfully submit the basis for the outstanding rejection is misconstruing the teachings of Ginter and is not properly considering the claim features. The basis for the outstanding rejection is attempting to read Ginter onto the claim features in a way that is completely unrelated to the actual disclosures in Ginter. Ginter is simply not even directed to a similar device as claimed.

In further detail, Claim 1 initially recites:

accessing, by one of the computers on the network, a prescribed electronic information stored in prescribed one of plurality of client computers using information of its location from one of the computer servers based on a request from the prescribed one of the client computers[.]

With respect to the above-noted feature the outstanding Office Action cites Ginter at column 87, lines 15-40 and Figure 51H. However, that disclosure in Ginter has no relation whatsoever to the above-noted claim feature.

The above-noted claim feature is directed to allowing one computer on a network to have electronic information stored in that one computer accessed by another computer. At

Figure 51H and at column 87, lines 15-40, Ginter discloses an operation of a “virtual entity” being accessed. However, that disclosure does not disclose at any point that one computer server on a network accesses prescribed electronic information stored in another client computer based on a request from the client computer. There is no disclosure whatsoever in Ginter that the “virtual entity” is another network on the computer or that the access is to a prescribed electronic document therein.

Moreover, the next operation in Claim 1 is “attaining, by the one of the computer servers on the network, a copy of the prescribed electronic information”. That is, at a next claimed operation the prescribed electronic information is obtained. To meet that limitation the outstanding Office Action jumps to the disclosure in Ginter at column 10, lines 15-27 and Figure 4.

In that respect, applicants note the disclosure in Ginter at column 10, lines 15-27 and Figure 4 is completely unrelated to the previously cited disclosure in Figure 51H and at column 87, lines 15-40. In contrast, in the claims the same electronic information that is accessed is then obtained. The disclosure in Ginter at column 10, lines 15-27 and in Figure 4 has no relation whatsoever to such an operation, and has no relation whatsoever to the disclosure at column 87, lines 15-40. More particularly, at column 10, lines 15-27 Ginter merely discloses a Distributed Commerce Utility that can be utilized for electronic commerce. That disclosure is completely silent as to obtaining a copy of previously accessed electronic information.

Similarly, the other noted disclosures in Ginter are unrelated to the above-noted disclosures in Ginter. In contrast, the claims set forth other operations that are all directed to accessing and obtaining the same specific prescribed electronic information.

As noted above, one benefit of the claimed invention is allowing prescribed electronic information to be available as prior art by authenticating when it was made available to the public. Ginter at no point discloses being able to realize any similar result.

With specific respect to the further cited portions in Ginter, at column 99, lines 23-55 Ginter provides no disclosure whatsoever to generating attribute information for a previously accessed electronic information, and again that disclosure in Ginter has no relation whatsoever to the earlier cited disclosure in Ginter at column 87, lines 15-40 and in Figure 51H directed to accessing a prescribed electronic information.

The further cited disclosure in Ginter at column 82, lines 34-50 directed to generating an electronic certificate is also unrelated to the claimed features. The noted disclosure in Ginter at column 82, lines 34-50 does indicate utilizing a certifying authority 500A. However, that disclosure is, as indicated in Ginter, directed to issuing a certificate such as "This person is officially associated with the institution 1060".³ Such a disclosure of a certificate in Ginter is completely unrelated to any previously accessed prescribed electronic information.

Moreover, Ginter does not provide any disclosure with respect to the claimed features of obtaining and storing the prescribed electronic information in a memory associated with one of the computer servers on the network, and storing the electronic information in a second memory associated with one of the computer servers on the network. The further cited disclosures in Ginter at column 84, lines 1-3, column 118, lines 10-34, and column 40, lines 30-45 are completely unrelated to such claimed features. Those disclosures in Ginter are also completely unrelated to the originally cited disclosure in Ginter at column 87, lines 15-40 and in Figure 51H, cited with respect to the initially claimed feature of accessing prescribed electronic information.

³ See specifically Ginter at column 82, lines 42-43.

Applicants also note, in further detail, that at column 84, lines 1-3 Ginter merely uses the word “certificate”, but is directed to certifying that a certain *person is married to another person*. How such a disclosure in Ginter is at all related to any of the claimed features is completely not understood, as such a disclosure in Ginter is not even directed to an *electronic certificate*.

Further, at column 118, lines 10-34 Ginter again utilizes the word “certificate” but in a manner unrelated the claimed features, and particularly unrelated to previously accessed prescribed electronic information.

Further, at column 40, lines 30-45 Ginter does not appear to even disclose or suggest any storing of an electronic information that was previously accessed from another client computer.

In such ways, applicants respectfully submit the cited disclosures in Ginter are completely unrelated to the claimed features, and that the outstanding rejection is misconstruing the teachings in Ginter relative to the claimed features. Applicants also again note the cited disclosures in Ginter are not even related amongst themselves, and appear to be directed to unrelated aspects disclosed in Ginter.

In such ways, independent claim 1, and the claims dependent therefrom, are believed to clearly distinguish over the applied art to Ginter.

Moreover, applicants the other independent claims recite similar features as in independent claim 1 noted above, and thus are believed to also distinguish over the teachings in Ginter for similar reasons as discussed above.

As no other issues are pending in this application, it is respectfully submitted that the present application is now in condition for allowance, and it is hereby respectfully requested that this case be passed to issue.

Respectfully submitted,

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